

REMARKS

Claims 1-14, 17, 18 and 21-29 have been amended for matters of style and as set forth below. Claims 1-30 are pending in this application.

Claim 1 has been amended to recite “an isolated cytokine-binding domain”. Support for this amendment can be found at page 8, ll. 25-27 and page 21, ll. 11-16 of the specification as filed.

Claims 8, 9, 10, 14 and 28 have been amended to use classical Markush group form. Support for this amendment can be found at page 7, ll. 26-32, pg. 8, ll. 1-4 and pg. 16, ll. 1-3 of the specification as filed.

No new matter has been added by way of these amendments.

The Restriction Requirement

The Examiner has required a restriction of the pending claims to one of the following groups:

Group I. Claims 1-11, drawn to a cytokine binding domain of a cytokine receptor, classified in class 530, subclass 350.

Group II. Claims 12-15, 28-29, drawn to a method of identifying a compound having cytokine agonist or antagonist activity using a cytokine binding domain of a cytokine receptor, classified in class 435, subclass 7.1.

Group III. Claim 16, 30, drawn to a cytokine agonist identified by a method of identifying a compound having cytokine agonist activity using a cytokine binding domain of a cytokine receptor, class and subclass undeterminable.

Group IV. Claims 16, 30, drawn to a cytokine antagonist identified by a method of identifying a compound having cytokine antagonist activity using a cytokine binding domain of a cytokine receptor, class and subclass undeterminable.

Group V. Claim 17, drawn to an antibody to a cytokine binding domain of a cytokine receptor, classified in class 530, subclass 387.1.

Group VI. Claim 18, drawn to a mutant cytokine binding domain of a cytokine receptor, classified in class 530, subclass 350.

Group VII. Claim 19, 23, 25, 27, drawn to a method of treating a cytokine related condition by administering an agonist to a cytokine binding domain of a cytokine receptor, class and subclass undeterminable.

Group VIII. Claim 19, 23, 25, 27, drawn to a method of treating a cytokine-related condition by administering an antagonist to a cytokine binding domain of a cytokine receptor, class and subclass undeterminable.

Group IX. Claims 20-22, 24, 26, drawn to a method of treating a cytokine-related condition by administering an antibody to a cytokine binding domain of a cytokine receptor, classified in class 424, subclass 139.1.

Claim Group Election

In response to the Requirement for Restriction, Applicants hereby provisionally elect, with traverse, to prosecute claims 1-11, corresponding to Group I. It is respectfully submitted that Groups I and II, i.e., claims 12-15, 28-29, should be examined in the same application, for the reasons set forth below.

The Examiner contends that inventions I and II are related as product and process of use, and that the product can be used in a materially different process such as an antigen in the production of antibodies. Contrary to the Examiner's reasoning, however, the process of invention II incorporates all limitations of the product of invention I via direct or indirect dependence from claim 1 of elected invention Group I, as assigned by the Examiner. According to the Manual of Patent Examining Procedure, § 821.04,

... process claims that depend from or otherwise include all the limitations of the product can be entered as a matter of right if the amendment is presented prior to final rejection or allowance.

It follows that inventions I and II fulfill the criteria for rejoinder of MPEP §821.04, as invention II is an example of a process that depend from or otherwise include all the limitations of the product of invention I. See, also, 37 C.F.R. §1.144; and *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995). See also MPEP § 2116.01. The claims of Group II are thus properly examined with the claims of Group I, and rejoinder of at least inventions I and II is requested.

Further restriction within elected Group I is required by the Examiner, i.e., a single element of claim 9 and claim 10 should be elected. Accordingly, Applicants elect, with traverse, IL-3 receptor with respect to claims 9 and 10.

The Examiner alleges that claims 9, 10, 14 and 28 are improper Markush claims because the multiple elements recited in these claims do not share a common technical feature based on a common property or special technical feature not found in the prior art. Contrary to the Examiner's reasoning, it is respectfully submitted that the receptors recited in claims 9 and 10 share a common technical feature based on the common property of having "seven residues that are strictly conserved across the receptors, all of which appear to play structural roles." *See*, page 8, ll. 6-9 of the specification. This common structural property distinguishes the receptors recited in the amended claims 9 and 10 as a group from structurally related compounds of the prior art. Accordingly, Applicants respectfully request that the Examiner withdraw the Restriction Requirement applied to claims 9 and 10, in view of the above arguments and amendments.

With regard to claims 14 and 28, contrary to the Examiner's allegations, it is respectfully submitted that the cytokines recited in these claims share the common property of mediating eosinophil activation. *See*, page 18, ll. 30-31 of the specification. Therefore, Applicants reserve their right to search and examination of the cytokines recited in claims 14 and 28, as amended herein, i.e., IL-3, IL-5, GM-CSF, IL-4 and IL-13, in case the Examiner rejoins Groups I and II.

Species Election

The Examiner has further required election of specific species to which the pending claims shall be restricted if no generic claim is finally held to be allowable. In particular, the Examiner has required election of a single member from each of the following species groups, reading on the specified claims:

- (a) the different residues recited in claims 6-7, 11, 18, 23 and 24¹;
- (b) the different cytokines recited in claims 8, 14;
- (c) the different receptors recited in claim 10;
- (d) the different conditions recited in claims 21-22, 27, 28²;
- (e) the different receptors recited in claim 9.

In response, Applicants hereby elect, without traverse the following species:

Group (a) (residues): Tyr 421.

Group (b) (cytokines): IL-3 with regard to claim 8 of elected Group I and claim 14 of Group II in case the Examiner decides to rejoin claim Group II with elected Group I.

Groups (c) and (e) (receptors): IL-3 receptor with regard to claims 9 and 10 of elected Group I.

Group (d) (conditions): does not apply to the claims of elected Group I or to Group II.

All claims read on the elected species. Claims 1-5, 12-13, 16-17, 19-20, 29-30 are generic. Applicants note that upon allowance of a generic claim, they will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of the allowed generic claim.

¹ It is respectfully noted that no residues are recited in claims 23 or 24.

² It is respectfully noted that no conditions are recited in claim 28.

CONCLUSION

Therefore, in view of the above amendments and remarks, it is respectfully requested that the restriction requirement be reconsidered.

If there are any other issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Dated:

Respectfully submitted,

By 

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